

REMARKS

Applicants request favorable reconsideration of this application in view of the foregoing amendments and the following remarks. Of claims 1-2, 4-11, 13, 26, 27, and 29-38 which were pending in the application, claims 13, 26, 27, and 29-38 stand withdrawn and claims 1, 2 and 4-11 were rejected in the Office Action. Applicants acknowledge that the Examiner has deemed claim 13 as being withdrawn as a result of the previous amendment thereto to include the limitations of previously withdrawn (and correspondingly cancelled) claim 28.

By way of this amendment, Applicant has amended claims 1, 7-9, and 11. Claim 9 has been amended to depend from claim 8 and claim 11 has been amended to be in independent claim format.

It is respectfully requested that this amendment be considered and entered, as it is believed to place this application in condition for allowance.

1. Rejection of Claims 1, 2, and 4-10

The Examiner rejected claims 1, 2, 4-6, 9, and 10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,095,239 ("Makino"). In addition, the Examiner rejected claims 7, 8, and 11 under 35 U.S.C. § 103(a) as being obvious in view of Makino. Applicants respectfully traverse each of these rejections. Preliminarily, Applicants assert that the rejection under § 102(b) was inappropriate, as § 102 provides (with italic emphasis added):

A person shall be entitled to a patent unless
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, *more than one year prior to the date of the application for patent in the United States*[.]

Makino issued on August 1, 2000 and the instant application was filed, in the U.S., on February 8, 2001. As a result, Makino issued roughly six months before the instant application was filed, *i.e.*, Makino issued less than "one year prior to the date of the application." Accordingly, Makino is inapplicable under § 102(b). However, as Makino is applicable under 35 U.S.C. § 102(e), Applicants assume that the Examiner intended to reject claims 1, 2, 4-6, 9, and 10 under § 102(e) (as was done in previous Office Actions), and respond accordingly.

a. Rejection of Claims 1, 2, 4-6, 9, and 10

Preliminarily, with respect to claims 9 and 10, this rejection is now moot due to the amendment of claim 9 (from which claim 10 depends) to depend from independent claim 8, which as later explained in detail is allowable in its currently unamended form. Accordingly, the rejection will be addressed with respect to claims 1, 2, and 4-6.

Applicants reassert the arguments previously set forth in the response filed on October 24, 2003. Specifically, Applicants continue to assert that the third louver in Makino (louver 67, 67a) is not "in the vicinity of an innermost one of said first louvers" (louvers 65 of first heat exchanger 21), as previously recited in claim 1. However, due to the Examiner's interpretation of the word "vicinity" as being "near," Applicants have amended claim 1 to recite that the third louver is "positioned closer to an innermost one of said first louvers than to the innermost one of said second louvers."

As clearly shown in the disclosed embodiment of Figures 21-23 of Makino, the third louver 67, 67a is positioned closer to an innermost one of the louvers 65 of the *second* heat exchanger 23 rather than the innermost one of the louvers 65 of the *first* heat exchanger 21. In other words, the third louver 67, 67a is closer to the second louvers and, therefore, its positioning is directly contrary to the limitations of claim 1. Moreover, this is not merely a matter of semantics, as Makino teaches that the operating temperature of the first heat exchanger 21 is higher than the operating temperature of the second heat exchanger 23. *See* Makino at col. 9, lines 32-39.

As Makino fails to teach or suggest each of the limitations of claim 1, it can not be used to reject the claim, or any claim dependent thereon, under 35 U.S.C. § 102(e). Therefore, the rejection of claim 1 under § 102(e) should be withdrawn. Further, as each of claims 2 and 4-6 depends from claim 1, each of these dependent claims is also allowable over Makino, without regard to the other patentable limitations recited therein. Accordingly, Applicants respectfully request a withdrawal of the rejection of claims 1, 2, and 4-6 under § 102(e).

b. Rejection of Claims 7, 8, and 11

The rejection of claims 7, 8, and 11 is traversed under 35 U.S.C. § 103(c) which precludes the application of prior art, under 35 U.S.C. § 103(a), which was commonly owned at the time of the recited invention. Specifically, § 103(c) provides (with italic emphasis added):

- (c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, *shall not preclude patentability under this section* where the subject matter and the claimed invention were, at the time the invention was made, *owned by the same person or subject to an obligation of assignment to the same person.*

As previously discussed, Makino is only applicable under 35 U.S.C. § 102(e) and, therefore, 35 U.S.C. § 103(c) is applicable to preclude a holding of obviousness to claims 7 and 8 under 35 U.S.C. § 103(a). The Examiner improperly asserts (on page 3 of the Office Action) that § 103(c) is inapplicable because the inventors of Makino and the instant application are

different. Section 103(c) does not, however, require that the inventors be the same. Rather, § 103(c) precludes a finding of obviousness under § 103(a) "where the subject matter and the claimed invention were, at the time the invention was made, *owned by the same person or subject to an obligation of assignment to the same person.*"


In this case, at the time of the invention, the CalsonicKansai Corporation was the assignee of both Makino and the current application. Accordingly, § 103(c) precludes the applicability of Makino under § 103(a) and, therefore, the rejection of claims 7, 8, and 11 under § 103(a) must be withdrawn. In addition, as claims 9 and 10 now depend from claim 8, each of these claims is also allowable, without regard to the other patentable limitations recited therein.

CONCLUSION

For the aforementioned reasons, claims 1, 2, and 4-11 are now in condition for allowance. A Notice of Allowance at an early date is respectfully requested. The Examiner is invited to contact the undersigned if such communication would expedite the prosecution of the application.

Respectfully submitted,

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